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| APPLICATION NO.                                                                                  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--------------------------------------------------------------------------------------------------|-------------|----------------------|---------------------|------------------|
| 10/595,593                                                                                       | 04/28/2006  | Kensuke Orito        | SC-IAT-107          | 3186             |
| 69296 7590 11/07/2008<br>VON SIMSON & CHIN<br>62 WILLIAM STREET, 6TH FLOOR<br>NEW YORK, NY 10005 |             |                      |                     |                  |
| EXAMINER                                                                                         |             |                      |                     |                  |
| PANI, JOHN                                                                                       |             |                      |                     |                  |
| ART UNIT                                                                                         |             | PAPER NUMBER         |                     |                  |
| 3736                                                                                             |             |                      |                     |                  |
| MAIL DATE                                                                                        |             | DELIVERY MODE        |                     |                  |
| 11/07/2008                                                                                       |             | PAPER                |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/595,593

**Applicant(s)**

ORITO ET AL.

**Examiner**

JOHN PANI

**Art Unit**

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,6,7,9,12-14 and 16 is/are pending in the application.
- 4a) Of the above claim(s) 12-14 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,6,7 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/08)  
Paper No(s)/Mail Date 8/19/08
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Objections*

1. Claims 1 and 7 are objected to because of the following informalities:

#### In reference to Claim 1

It is suggested to move "once every one frame or plural frames" from line 10 and insert it in line 8 after "means for extraction" in order to increase the clarity of the claim.

In line 14 it is suggested to insert --at least one of:-- after "means for extracting", and to replace "and/or" in line 15 with --and-- in order to increase the clarity of the claim.

In line 15 it is suggested to delete "plural".

In line 17 it is suggested to insert --at least one of:-- after "means for judging." It is suggested to replace "and/or" in line 18 with --and--. In line 18 it is further suggested to insert --at least one of:-- after "based on". In line 19 it is suggested to replace "and/or" with --and-- and to insert --,-- after "coordination".

In lines 45-46 it is suggested to replace "three or four markers attached to three limbs or four limbs out of the four limbs" with --three markers attached to three out of the four limbs or four markers attached to the four limbs-- in order to increase the clarity of the claims.

#### In reference to Claim 6

It is suggested to replace "a substance that emits light when receiving ultraviolet or a phosphor" with --a phosphor or a substance that emits light when receiving ultraviolet-- in order to increase the clarity of the claim.

In reference to Claim 7

Line 9 of claim 7 through the final line of claim 7 are identical in content to line 8 of claim 1 through the final line of claim 1. Each of the issues previously discussed with regards to these lines of claim 1 are also exhibited in the corresponding text of claim 7.

Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 6 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In reference to Claim 6

Claim 6 recites the "infant movement analysis system according to claim 1, wherein *the markers attached to the four limbs of the infant* are coated" [emphasis added], thus claiming the device in combination with the infant. Living matter (in this case "the infant") which is not the result of human intervention is non-statutory matter. See MPEP § 2105 [R-1].

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 3, 6, 7, and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In reference to Claim 1

Line 2 recites "an imaging device that photographs." It is unclear whether the system is directed to an apparatus or method. The lack of clarity regarding the scope of the claim renders it indefinite. It is suggested to replace "that photographs" with –is configured to photograph--.

Line 4 recites "an analyzing device that determines." It is unclear whether the system is directed to an apparatus or method. The lack of clarity regarding the scope of the claim renders it indefinite. It is suggested to replace "that determines" with –is configured determine—and replace "identifies" in line 5 with –identify--.

Lines 15-16 recite "coordination among the plural limbs, in the movements of the four limbs determined by said limb movement determining means." It is unclear whether "in the movements of the four limbs determined by said limb movement determining means" is modifying "coordination among the plural limbs", each of "right-left synchronism of the arms or the legs", "right-left symmetry of the arms or legs", and "coordination among the plural limbs" or is instead modifying "for extracting" in line 14. It appears that the latter is intended, and it is suggested to replace "in the movements" with –from the movements—and to move "from the movements of the four limbs determined by said limb movement determining means" to line 14 directly after "means for extracting."

Line 17 recites "means for judging existence/nonexistence or a value of possibility of a disease." It is unclear whether the means is for judging either existence/nonexistence of a disease, or a value of possibility of a disease, or instead if the means is for judging either existence/nonexistence (of some indefinite thing), or a possibility of a disease. If the former is the intention it is suggested to replace "means for judging existence/nonexistence or a value of possibility of a disease" with —means for judging existence/nonexistence of a disease, a value of possibility of a disease,—.

Line 20 recites "wherein said movement analyzing means determines." It is unclear whether the system is directed to an apparatus or method. The lack of clarity regarding the scope of the claim renders it indefinite. It is suggested to replace "means determines" with —means is configured determine—.

Lines 20-21 recite "analyzing means determines existence/nonexistence or a degree of coordination." It is unclear whether the means determines either the existence/nonexistence of coordination or a degree of coordination, or instead the means determines either the existence/nonexistence (of some indefinite thing), or a degree of the coordination. If the former is the intention it is suggested to replace "existence/nonexistence or a degree of the coordination among the plural limbs" with —existence/nonexistence of the coordination among the plural limbs, or a degree of the coordination among the plural limbs."

Lines 33-34 recite "a straight line connecting two markers attached to a left arm and a marker attached to a right arm." It is unclear if there are three markers, two on a

left arm and one on a right arm, or instead of there are two markers, one on the left arm and one on the right arm.

Lines 36-37 recite "a straight line connecting two markers attached to left leg and right leg." It is unclear whether there are four markers, with two attached to the left leg and two to the right leg, or if there are two markers, one attached to the left leg and one to the right leg.

Lines 39-40 recite "a straight line connecting two markers attached to the left arm and the right leg." It is unclear whether there are four markers, with two attached to the left arm and two to the right leg, or if there are two markers, with one attached to the left arm and one to the right leg.

Lines 42-43 recite "a straight line connecting two markers attached to the left leg and the right arm." It is unclear whether there are four markers, with two attached to the left leg and two to the right arm, or if there are two markers, with one attached to the left leg and one to the right arm.

In reference to Claims 3 and 9

Line 2 recites "means extracts." It is unclear whether the system is directed to an apparatus or method. The lack of clarity regarding the scope of the claim renders it indefinite. It is suggested to replace "means extracts" with --means is configured to extract--.

Line 3 recites "means determines." It is unclear whether the system is directed to an apparatus or method. The lack of clarity regarding the scope of the claim renders it

indefinite. It is suggested to replace "means determines" with --means is configured to determine--.

In reference to Claim 6

Line 2 recites "the markers." It is unclear whether "The markers" have previously been positively claimed as part of the system and therefore appear they may lack antecedent basis in the claims. If "The markers" are indeed intended to be positively claimed please see rejections based on 35 U.S.C. 101 above.

In reference to Claim 7

Lines 2-5 recite "a database that stores movement data indicating histories of movements of four limbs of an infant, the movements being determined from a motion picture of the infant photographed by an imaging device that photographs an infant to output a motion picture of the infant as digital data." It is unclear whether the database being claimed actually physically contains "movement data indicating histories of movements" which was already obtained "from a motion picture of the infant photographed by an imaging device that" photographed "an infant" and "output a motion picture of the infant as digital data", or if it instead is merely configured to store movement data which may have been gathered in this way. If the former is the intention it is suggested to replace "the movements being determined from a motion picture of the infant photographed by an imaging device that photographs an infant to output a motion picture of the infant as digital data" with --wherein the movements were determined from a motion picture of the infant photographed by an imaging device that photographed an infant and output a motion picture of the infant as digital data--. If the latter is the



intention, it is unclear whether a method or apparatus is being claimed, and is suggested to replace "that stores" with --configured to store--.

Line 6 recites "an analyzing device that identifies." It is unclear whether the system is directed to an apparatus or method. The lack of clarity regarding the scope of the claim renders it indefinite. It is suggested to replace "that identifies" with --is configured to identify--.

Line 9 of claim 7 through the final line of claim 7 are identical in content to line 8 of claim 1 through the final line of claim 1. Each of the issues previously discussed with regards to these lines of claim 1 are also exhibited in the corresponding text of claim 7.

#### ***Response to Arguments***

5. Applicant's arguments, see pg. 8 paragraph 5 - pg. 9 paragraph 1, filed 8/19/2008, with respect to claims 3 and 9 have been fully considered and are persuasive. The rejection of 4/17/2008 under 35 U.S.C. 112 second paragraph has been withdrawn.

6. Applicant's arguments, see pg. 9, paragraph 4, filed 8/19/2008, with respect to claim 6 have been fully considered and are persuasive. The rejection of 4/17/2008 under 35 U.S.C. 112 second paragraph has been withdrawn.

#### ***Allowable Subject Matter***

7. Claims 1 and 7 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

8. Claims 3, 6, and 9 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph and 35 U.S.C. 101, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN PANI whose telephone number is (571)270-1996. The examiner can normally be reached on Monday-Friday 7:30 am - 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 571-272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JP 11/6/08

/Max Hindenburg/

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Supervisory Patent Examiner, Art Unit 3736